

REMARKS/ARGUMENTS

Claims 1, 4-9, 11-14, 16, 17, 19-21, and 25 are pending in this application. Claims 2-3, 10, 15, 18, and 22-24 have been cancelled without prejudice.

Claim Rejections- 35 U.S.C. § 102

The Patent Office rejected Claims 1, 9, 10-12, 14, 16-17, and 19-21 under 35 U.S.C. § 102(b) as being anticipated by Fibre Channel Framing and Signaling working draft proposal, ("FC-FS Draft Standard," Rev. 1.30 published on July 9, 2001). Applicants respectfully traverse.

According to 35 U.S.C. § 102(b), one is entitled to a patent unless "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States." 35 U.S.C. § 102(b). Applicants respectfully submit that the present reference FC-FS Draft Standard does not satisfy the criteria set-forth by 35 U.S.C. § 102(b) for the publication was not printed more than one year prior to the date of application for the present patent – FC-FS Draft Standard published on July 9, 2001, filing date of present application, October 31, 2001. Therefore, Applicants respectfully request that the present 35 U.S.C. § 102(b) be withdrawn and the pending claims be allowed.

In the event that the present reference FC-FS Draft Standard were to be asserted as a 102(a) reference, Applicants respectfully submit that such reference would still fail to establish anticipation for Claim 1, along with Claims 9 and 16, include elements that have not been taught, disclosed or suggested by FC-FS Draft Standard. For example, FC-FS Draft Standard fails to teach, disclose or suggest "a multi-ported system" as recited in Claim 1. As stated in the Office Action, the diagram shown in the FC-FS-Draft (pages 532-533) only presents two ports. The Patent Office then asserts that the diagram could be inherently extended to cover all ports in the chain. Applicants respectfully disagree.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). If anticipation is based upon the inherent teaching of a prior art reference, the Examiner must provide a rationale or evidence tending to show inherency. As stated in *In re Robertson*, “to establish inherency the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill.” (emphasis added) *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Additionally, “inherency, however, may not be established by probabilities or possibilities.” *Id.* Moreover, “the mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.*

Here, the missing descriptive matter “a multi-port” or more than a two port system is not necessarily present in the FC-FS Draft Standard. For instance, a typical fibre channel system is described by Wall (U.S. Patent 6,507,923) as including one or two ports. Wall et al., U.S. Patent 6,507,923, Background of the Invention. As stated previously, “the mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Accordingly, the rejection of Claim 1 should be withdrawn, and Claim 1 is allowable for the FC-FS Draft Standard fails to explicitly or implicitly teach, disclose, or suggest use of a multi-port system. Claims 9 and 16 are believed allowable for similar reasoning. Claims 10-12, 14, 17, and 19-21 are believed to be allowable based on their dependence upon allowable base claims.

It is believed that the pending rejection relying upon the FC-FS Draft Standard cannot be maintained for at least the reasons set forth above. However, it is noted that Applicants’ conception date pre-dates the priority date of the FC-FS Draft Standard. Therefore, Applicants respectfully reserve the right to swear behind the FC-FS Draft Standard in the event that the 102(b) reference is asserted as a 102(a) reference.

Claim Rejections – 35 U.S.C. § 103

The Patent Office rejected Claims 4, and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over FC-FS Draft Standard. The Patent Office rejected Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over FC-FS Draft Standard and Wall et al. (“Wall”, U.S. Patent No. 6,507,923). Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over FC-FS Draft Standard and Mulvey et al. (“Mulvey”, U.S. Patent No. 6,629,219). Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over FC-FS Draft Standard and ordinary skill in the art. Applicants respectfully traverse these rejections.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Further, “to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As indicated in the foregoing Claim Rejections – 35 USC § 102 section, the primary reference, FC-FS Draft Standard fails to disclose, teach or suggest all the elements recited in Claims 1, 9 and 16. Applicants respectfully submit that any of the ancillary references (Wall and Mulvey) or ordinary skill in the art does not make up for the defects of FC-FS Draft Standard.

Wall is cited for the disclosure of use of a third channel in the system which the Patent office admitted that FC-FS Draft Standard does not explicitly disclose. Further, Mulvey is cited for the disclosure of a by-pass selector section which can by-pass disk drives, which the Patent office admitted that FC-FS Draft Standard does not explicitly disclose. However, neither Wall or Mulvey cure the defect of FC-FS Draft Standard in reference to Claims 1, 9 and 16 for they do not explicitly or implicitly teach or suggest "a multi-port system" as recited in Claim 1.

In regards to Claim 25, as the Examiner is well aware, Applicants are required to seasonably challenge statements by the Examiner that are not supported on the record, and failure to do so will be construed as an admission by the Applicants that the statement is true. M.P.E.P. §2144.03. Therefore, in accordance with such duty to seasonably challenge such unsupported statements, the Examiner is hereby requested to cite a reference supporting the position that it would have been obvious to change speed at all ports in the daisy chain in accordance with the claimed invention. If the Examiner is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicants hereby request that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Thus, independent Claims 1, 9, and 16 are nonobvious under 35 U.S.C. § 103(a). Claims 4, 6-7, 13, and 25 are believed to be allowable based on their dependence upon allowable base claims. Removal of all the pending rejections under 35 U.S.C. §103 is respectfully requested.

CONCLUSION

In light of the forgoing amendments and arguments, reconsideration of the claims is hereby requested, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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